

**REMARKS/ARGUMENTS**

Claims 1-69 are pending in the present application. In the Office Action mailed May 18, 2005, the Examiner rejected claims 1-69 under 35 U.S.C. § 103(a). Reconsideration is respectfully requested in view of the above amendments to the claims and the following remarks.

**A. Rejection of Claims 1-15, 24-31 and 42-49 Under 35 U.S.C. § 103(a)**

The Examiner rejected claims 1-15, 24-31 and 42-49 under 35 U.S.C. § 103(a) based on U.S. Patent No. 6,160,477 to Sandelman et al. (hereinafter, "Sandelman") in view of U.S. Publication No. 2002/0019712 to Petite et al. (hereinafter, "Petite") and in further view of U.S. Publication No. 2002/0198978 to Watkins (hereinafter, "Watkins"). This rejection is respectfully traversed.

The M.P.E.P. states that

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

M.P.E.P. § 2142.

Applicants respectfully submit that the claims at issue are patentably distinct from the cited references. The cited references do not teach or suggest all of the limitations in these claims. Specifically, claim 1 recites that the communications module comprises both "a paging module ... for communicating with a computer through a paging network" and "a modem ... for communicating

with the computer through a communications network.” The other claims at issue include identical or similar limitations.

In response to the Applicants’ arguments filed January 24, 2005, the Examiner in the Office Action on page 2 stated that “the message delivery server [of Sandelman] can access a paging network to send messages (See Column 7 lines 18-21) thus it would have been obvious ... to use the paging module of Watkins in the electronic delivery server as an alternative means for accessing the paging network.” However, column 7, lines 18-21 of Sandelman that the Examiner cites, does not support the Examiner’s assertion. Specifically, column 7, lines 18-21 states “In FIG. 3c, server 1 sends the message over a telephone line 18c to the user's pager service 53 and thence to the user's pager or PCS 8.” (Emphasis added). In fact, column 7, lines 18-21 of Sandelman supports the Applicants’ assertion that Sandelman itself says nothing about the desirability of having two alternative means of communication in the electronic message delivery server 1 as claimed in claims 1-15, 24-31 and 42-49.

The message delivery server 1 of Sandelman itself only includes a single means of communication. Specifically, the message delivery server 1 of Sandelman is only equipped to send messages “over a telephone line.” As noted previously in the Applicants’ arguments filed January 24, 2005, Sandelman states:

FIGS. 3a-d show a more detailed view of the various outbound links 12a-d that connect the server 1 to the various electronic media. In FIG. 3a, server 1 sends the message over a telephone line 18a to the Internet 122 and deposits the message in the user's e-mail box 6. In FIG. 3b, server 1 sends the message over a telephone line 18b through the public telephone switched network (PTSN) 19 to the user's fax machine 7. In FIG. 3c, server 1 sends the message over a telephone line 18c to the user's pager service 53 and thence to the user's pager or PCS 8. In FIG. 3d, server 1 sends the message over a telephone line 18d through the PTSN 19 to the user's voice mail box 9.

Sandelman, col. 7, lines 9-23 (emphasis added). Therefore, the message delivery server 1 only includes a single means of communication, presumably a telephone modem. Nowhere in Sandelman is there any teaching or suggestion that it would be desirable to include an alternative means of communication in the message delivery server 1, as the Examiner proposes. Furthermore, the

Examiner has failed to point to any teaching or suggestion in Sandelman that it would be desirable to include an alternative means of communication in the message delivery server 1.

Similarly, Watkins also does not include any teaching or suggestion about the desirability of having two alternative means of communication in a communications module. As indicated above, Watkins merely states that “[e]xamples of communication modules 22 are 1way paging data receivers, 2-way paging data receivers/transmitters ....” Watkins, par. 35. Thus, at the very most Watkins teaches that a communications module 22 may be embodied as a 1-way or 2-way pager. However, there is no teaching or suggestion in Watkins that two different types of communication modules 22 may be used with one another, and certainly not that a pager may be used together with a modem.

Petite is also silent about the desirability of having two alternative means of communication in a communications module. As indicated above, Petite teaches that “one or more site controllers 150 and the applications server 110 may communicate via one or more communication networks, such as a wide area network (WAN) 120 or other suitable communication network.” Petite, par. 23. However, there is no teaching or suggestion that the site controllers 150 are configured to communicate with the applications server 110 via two different types of communication networks. The vague reference to “one or more communication networks” certainly cannot be construed as such a teaching or suggestion. Petite specifically mentions only one type of communication network, namely a WAN 120.

Therefore, the Examiner has not pointed to any part of the cited references as suggesting the desirability of having both a paging module and a modem together in a single communications module. The only place where Applicants have found any teaching regarding the desirability of this combination is in Applicants’ own disclosure. Accordingly, it appears that the Examiner has simply “take[n] the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight.” In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999)). The MPEP warns against this kind of improper hindsight reasoning:

To reach a proper determination under 35 U.S.C. 103, the examiner must step

backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made. ... The tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

MPEP § 2142 (emphasis added). In the Office Action on page 3, the Examiner noted that:

it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. *See In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

However, the Examiner has failed to point to facts or knowledge within the level of ordinary skill at the time the claimed invention was made to support the Examiner's teaching or suggestion of the desirability of having both a paging module and a modem together in a single communications module.

To provide a suggestion, the Examiner has only stated that Sandelman can access a paging network through a telephone line 18c. However, this assertion does not teach or suggest the desirability of having both a paging module and a modem together in a single communications module. Furthermore, MPEP 2143.01 states that "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." Therefore, the Examiner has not provided a motivation to combine Sandelman with Watkins and appears to be using improper hindsight reasoning to reject claims 1-15, 24-31 and 42-49.

In view of the foregoing, Applicants respectfully submit that independent claims 1, 25, and 43 are patentably distinct from the cited references. Accordingly, Applicants respectfully request that the rejection of these claims be withdrawn.

Claims 2-15 and 24 depend either directly or indirectly from claim 1. Claims 26-31 and 42 depend either directly or indirectly from claim 25. Claims 44-49 depend either directly or indirectly from claim 43. Accordingly, Applicants respectfully request that the rejection of claims 2-15, 24, 26-31, 42, and 44-49 be withdrawn for at least the same reasons as those presented above in connection with claims 1, 25, and 43.

B. Rejection of Claims 16-23, 32-41 and 50-69 Under 35 U.S.C. § 103(a)

The Examiner rejected claims 16-23, 32-41 and 50-69 under 35 U.S.C. § 103(a) based on Sandelman in view of Petite and Watkins, and in further view of U.S. Publication No. 2002/0016639 to Smith et al. (hereinafter, "Smith"). This rejection is respectfully traversed.

The standard for establishing a rejection under 35 U.S.C. § 103(a) is provided above. Applicants respectfully submit that the claims at issue are patentably distinct from the cited references. The cited references do not teach or suggest all of the limitations in these claims.

The claims at issue relate to a communications module for facilitating electronic communications with an electronic device. Some of the claims at issue depend from claim 1, which recites that the communications module comprises both "a paging module ... for communicating with a computer through a paging network" and "a modem ... for communicating with the computer through a communications network." The other claims at issue include identical or similar limitations.

As discussed above, Sandelman, Petite and Watkins do not teach or suggest a communications module that includes both a paging module and a modem and the Examiner has failed to properly provide a motivation to combine Watkins with Sandelman. Smith discloses "a software system that allows for control of, and/or communication with, end devices and communication systems that utilize different command and communications protocols and languages." Smith, par. 2. The system includes "software modules which are adapted to directly control different types of building systems." *Id.*, par. 90.

Appl. No. 09/922,813  
Amdt. dated August 18, 2005  
Reply to Office Action of May 18, 2005

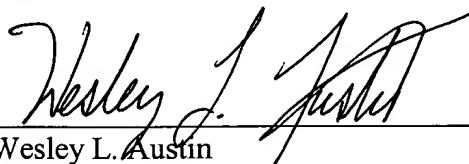
In the Office Action, the Examiner asserts that "messages to be sent to the various subsystems can be stored in a message queue" and "it would have been obvious ... to use the inbound message queue taught in Smith in the remote system of Sandelman." Office Action, page 17. Even if the Examiner's assertions were correct, this would not overcome the shortcomings of Sandelman, Petite and Watkins discussed above. Smith does not include any teaching or suggestion about the desirability of having two alternative means of communication in a communications module. Accordingly, the combined teachings of Sandelman, Petite, Watkins and Smith do not teach or suggest all of the limitations in the claims at issue.

In view of the foregoing, Applicants respectfully submit that claims 16-23, 32-41 and 50-69 are patentably distinct from the cited references. Accordingly, Applicants respectfully request that the rejection of these claims be withdrawn.

C. Conclusion

Applicants respectfully assert that all pending claims are patentably distinct from the cited references, and request that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Wesley L. Austin", written over a horizontal line.

Wesley L. Austin  
Reg. No. 42,273  
Attorney for Applicant

Date: August 18, 2005  
MADSON & METCALF  
Gateway Tower West  
15 West South Temple, Suite 900  
Salt Lake City, Utah 84101  
Telephone: 801/537-1700